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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/840,129

05/05/2004

Raymond Heidel

41286-00036

7232

7590

02/08/2006

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EXAMINER

SHAPIRO, JEFFERY A

ART UNIT

PAPER NUMBER

3653

DATE MAILED: 02/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/840,129	HEIDEL, RAYMOND	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jeffrey A. Shapiro	3653	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 December 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 26-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Information Disclosure Statement*

1. The information disclosure statement filed 5/5/04 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 26-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Katou et al (US 2004/0182677A1). Katou et al discloses a note validator (30), a validator processor (35) with memory (107d), a note box (60, 80 and 81), a temporary storage hopper (40), a transportation unit (501a-h), (502a-b), (503a-c), (504), (901a-e), (902a-e) and (903a-e), the notes being sent through validator (30) in either direction (501b). Note that the deposit/withdrawal port (20) can be construed as the validator opening, with the entire structure (1) being construed as the validator. Note also that bill

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discrimination unit (30) can be construed as inherently sensing actual bill pattern information for comparison with template patterns stored in memory (107d) and as inherently determining the value of bills detected as received and dispensed by the apparatus.

4. Claims 26-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Graef et al (US 6,315,194 B1). Graef et al discloses a note validator (72 and 258), a validator processor (254) with memory (256) (see also Graef col. 6, lines 10-25), a note box (30, 32, 34, 36, 38 and 40), of which any of said note boxes can be used as a temporary storage hopper, a transportation unit (17, 192, 285) (see also figures 12-15), the notes being sent through validator (72 or 258) in either direction. Note that the deposit/withdrawal port (20) can be construed as the validator opening, with the entire structure (10) being construed as the validator. Note also that bill discrimination/validator unit (72 and 258) can be construed as inherently sensing actual bill pattern information for comparison with template patterns stored in memory such as (256) and as inherently determining the value of bills detected as received and dispensed by the apparatus. See also Graef, col. 14, lines 11-55.

### ***Response to Arguments***

5. Applicant's arguments filed 12/8/05 have been fully considered but they are not persuasive. Applicant asserts that both Katou and Graef do not apply to Applicant's claims because they are not vending machines vending a product. First, Applicant's claims recite these limitations in the preamble of the claims. Therefore there is no

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patentable weight afforded them. Second, even if these claims had patentable weight, the automatic teller machine (ATM) of both Katou and Graef can be construed to be a vending machine because they both vend and dispense a product—money.

Applicant further asserts that Katou and Graef do not apply because they do not have note validators that discriminate notes based on authenticity, denomination, type and condition. The term “validator” or “discriminator” are considered to be terms of art in the banknote authentication art to mean a device which “senses” features of the bill and then accepts or rejects them based on said features as compared with data templates. Graef mentions a validator at col. 16, lines 1-20 and Katou mentions a similar device in the abstract as “a bill discriminating unit for discriminating bills”, for example.

First, Claim 26 is the only claim that recites the term “condition”. Second, validators necessarily sense data used to determine the denomination, such as the amount of money the note is valued at, authenticity or genuineness—that is, is it counterfeit, as well as is it the correct type. Type can be construed to be what currency, such as dollars, yen or euro. As to condition of notes, this is again a broad term that can have several definitions. Condition can be taken to be the over-all readability of the note. In the case of an unreadable note, the validator will necessarily reject it. Therefore, the note validators of Katou and Graef necessarily determine denomination, authenticity, type and condition. Further, Claim 26 has a phrase in lines 10-11 that reads “if said notes are of acceptable non-worn condition”. The term “non-worn” is a subjective criterion of a bill which can be construed as being of “readable”

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condition by the validator. It can be construed that all notes that are accepted by the validator are readable, and therefore are of non-worn or usable condition. Alternatively, non-worn can be construed to mean new bills that have never been in circulation before. Again, such new, non-worn bills are also readable by the validator, and can be authenticated.

Additionally, with regard to Katou, see figures 30a-c and 32-36, for example, that illustrate a "reject box" (65) in addition to a "temporary storage box" (40) and a "recycle box" (80). The existence of such a "reject box" and associated discussion within the reference suggests or implies that there are particular criteria used to reject bills and send them to such a "reject box".

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Anderson et al '795 is cited as disclosing a banknote discriminator with particulars of discrimination criteria discussed at col. 21, line 23-col. 27, line 45. Note particularly col. 22, lines 33-39 which discusses an "unfit document".

Jones et al '810 is cited as also disclosing such criteria at col. 9, lines 25-46, col. 11, lines 54-64, col. 17, lines 38-58, col. 26, lines 6-15, col. 28, lines 23-34, col. 29, lines 15-44, col. 30, lines 47-56, col. 31, lines 6-15, and figures 19b-19c.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Shapiro whose telephone number is (571)272-6943. The examiner can normally be reached on Monday-Friday, 9:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene O. Crawford can be reached on (571)272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

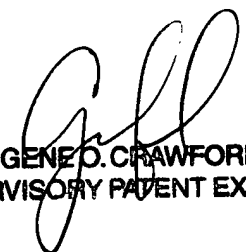
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey A. Shapiro  
Examiner  
Art Unit 3653

February 2, 2006



**GENE O. CRAWFORD**  
**SUPERVISORY PATENT EXAMINER**